

RESTRICTION REQUIREMENT

On pages 2 - 4 of the Office Action, all claims, namely claims 1 - 58, were placed under a restriction requirement. Pursuant to 37 CFR § 1.143 and MPEP § 818.03, Applicants herein elect, with traverse, Group I, consisting of claims 1 - 43 and 49 - 56.

REMARKS

In the Office Action, claims 1 - 58 were noted as pending in the application, and all claims were placed under a restriction requirement. Group I of the restriction requirement has been provisionally elected herein, but with traverse. However, Applicants believe the restriction requirement of the June 29, 2004 Office Action is in error and respectfully request reconsideration of original claims 1 - 58 in view of the following remarks.

Traversal of the Restriction Requirement

On page 2 of the Office Action, the claims have been classified into four groups, namely:

Group I Claims 1 - 43 and 49 - 56, allegedly drawn to a method providing an invitation to bid, classified in class 705, subclass 37.

Group II Claims 44 - 47 and 58, allegedly drawn to a system for managing bidding, classified in class 705, subclass 37.

Group III Claim 48, allegedly drawn to a method of determining pricing, classified in class 705, subclass 7.

Group IV Claim 57, allegedly drawn to bidding software, classified in class 705, subclass 37.

Applicants note that independent claim 48, the sole claim of Group III, is directed toward a method for carrying out an invitation for bids, much as independent claim 1 is directed toward the subject matter of a method for fulfilling an invitation for bids. However, unlike claim 1, claim 48 has been classified under Class 705, subclass 7. Class 705/7 is the classification for inventions directed toward operations research, where subclasses under operations research include allocating resources (705/8), staff scheduling or task assignment (705/9), market analysis (705/10), and job performance analysis (705/11). Clearly, operations

research or market analysis has nothing in common with the method for carrying out an invitation for bids as recited in claim 48; and classifying claim 48 in Class 705/7 is improper.

In fact, both the claims and the disclosure of the present application are completely silent regarding operations research, staff scheduling, market analysis, or the like. Instead, claim 48 is directed toward a method for carrying out an invitation for bids and should properly be classified under 705/37 for bidding, as claims 1 - 47 and 49 - 58 have correctly been classified. Since all claims presented herein should have been properly classified under 705/37, searching and examining these claims with their apparent common subject matter can be done without serious burden on either the Examiner or the Patent Office. For this reason, the restriction requirement being imposed on the pending claims is believed to be in error, and it is respectfully requested that the restriction requirement withdrawn.

As regards the alleged distinction between Groups I and II, the Office Action asserts that the inventions recited in these two groups should be examined separately because the method recited in Group I can be practiced by hand. The Applicants respectively disagree, noting that the specification clearly discloses that exemplary embodiments, including those recited in the Group I claims, are processed on a computer. See specification at Fig. 2 and paragraphs 30, 31, and 39 - 43. Further, the Office Action has acknowledged in the third paragraph of page 3 that the bidding method as recited in the claims of Group I is practiced on a computer system. Other than the Office Action's unsupported assertion, there is no evidence that the method recited in the claims of Group I can be practiced by hand; and the specification expressly states otherwise. Additionally, independent claim 1 at least recites providing a database comprising at least one performance description and at least one price description, wherein databases are disclosed herein, and are well known, to be computer-based. The database of claim 1 is unambiguously related through the specification to the data storage device of at least independent claims 44 and 58 of Group II (specification at paragraph 30). Also, the Office Action recognizes that the claims of Groups I and II are classified in the same class/subclass, namely class 705/subclass 37; which indicates that examination of the claims of both Groups I and II can be made without serious burden.

As regards the alleged distinction between Groups I and III, the Office Action asserts that the inventions recited in these two groups should be examined separately because Group

I has separate utility. In particular, the Office Action asserts that the inventions recited in Groups I and III are related as subcombinations usable together in a single combination and that the claimed invention of Group I has separate utility as a method for providing invitation to bidding using a different method for determining pricing. The Applicants respectfully disagree, noting that the Office Action has failed to describe this alleged combination for which the claims of Groups I and III are each respectively subcombinations. Further, the claims of Group I recite determining a price based on a price included in a bid submitted by a bidder. Since the claims of Group I expressly recited a method for determining pricing, they cannot possibly have separate utility for a feature they already recite.

As regards the alleged distinction between Groups I and IV, the Office Action asserts that the inventions recited in these two groups should be examined separately because the method recited in Group I can be practiced by hand. The Applicants respectfully disagree, noting that the specification clearly discloses that exemplary embodiments, including those recited in the Group I claims, are processed on a computer. See specification at Fig. 2 and paragraphs 30, 31, and 39 - 43. Further, the Office Action has acknowledged in the third paragraph of page 3 that the bidding method as recited in the claims of Group I is practiced on a computer system. Other than the Office Action's unsupported assertion, there is no evidence that the method recited in the claims of Group I can be practiced by hand; and the specification expressly states otherwise. Additionally, independent claim 1 at least recites providing a database comprising at least one performance description and at least one price description, wherein databases are disclosed herein, and are well known, to be computer-based. The database of claim 1 is unambiguously related through the specification to the database of claim 57 (specification at paragraph 30). Also, the Office Action recognizes that the claims of Groups I and IV are classified in the same class/subclass, namely class 705/subclass 37; which indicates that examination of the claims of both Groups I and IV can be made without serious burden.

As regards the alleged distinction between Groups II and III, the Office Action asserts that the inventions recited in these two groups should be examined separately because the method recited in Group III can be practiced by hand. The Applicants respectfully disagree, noting that the specification clearly discloses that exemplary embodiments, including those

recited in the Group III claim, are processed on a computer. See specification at Fig. 2 and paragraphs 30, 31, and 39 - 43. Further, the Office Action has acknowledged in the third paragraph of page 3 that the bidding method as recited in the claim of Group III is practiced on a computer system. Other than the Office Action's unsupported assertion, there is no evidence that the method recited in the claim of Group III can be practiced by hand; and the specification expressly states otherwise.

As regards the alleged distinction between Groups II and IV, the Office Action asserts that the inventions recited in these two groups should be examined separately because Group II has separate utility. In particular, the Office Action asserts that the inventions recited in Groups II and IV are related as subcombinations usable together in a single combination and that the claimed invention of Group II has separate utility as a computer system capable of executing different software. The Applicants respectfully disagree, noting that Office Action has failed to describe this alleged combination for which the claims of Groups II and IV are each respectively subcombinations. Further, the systems recited at least in independent claims 44 and 58 of Group II have computer-based system components directed to the details of a bidding invitation system. For example, claim 44 recites a data storage device storing performance descriptions and price descriptions; a communications device forwarding performance descriptions to a party submitting an invitation for bids; and a transmission device transmitting the received bids to the party submitting the invitation for bids. Other than the unsupported, speculative statement made in the Office Action, there is no evidence offered and certainly no disclosure within the specification that the computers shown in Figure 2, and as recited in Group II, execute software other than directed toward a bidding system. Nor has the Office Action described the particular different software that the invention of Group II is allegedly capable of executing.

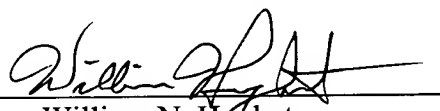
As regards the alleged distinction between Groups III and IV, the Office Action asserts that the inventions recited in these two groups should be examined separately because the method recited in Group III can be practiced by hand. The Applicants respectfully disagree, noting that the specification clearly discloses that exemplary embodiments, including those recited in the Group III claim, are processed on a computer. See specification at Fig. 2 and paragraphs 30, 31, and 39 - 43. Further, the Office Action has acknowledged in

the third paragraph of page 3 that the bidding method as recited in the claim of Group III is practiced on a computer system. Other than the Office Action's unsupported assertion, there is no evidence that the method recited in the claim of Group III can be practiced by hand; and the specification expressly states otherwise.

Summary

It is submitted that all of the claims are directed to related inventions, namely methods and systems for fulfilling invitations to bid, properly classified under Class 705, subclass 37, and are easily searched and examined in their entirety without serious burden. In fact, the Office Action admits that all the claims except claim 48 are properly classified together in Class 705, subclass 37; and the Applicants respectively submit that claim 48 properly should also be classified in Class 705/37. "If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. It is respectfully submitted that this policy should apply in the present application, where all claims should properly be classified in the same class, in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office. Reconsideration of the claims and an action on the merits of all originally-filed claims 1 - 58 are earnestly solicited. If any fees are required in connection with this Response, please charge the same to our Deposit Account No. 02-4800.

Respectfully submitted,
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
William N. Hugnet
Reg. No. 44,481

P.O. Box 1404
Alexandria, Virginia 22314-0404
Telephone: (703) 836-6620
Facsimile: (703) 836-2021
Date: July 26, 2004
VA 290828.1